

ATTORNEY DOCKET NO.: 053933-5008

Application No.: 09/821,738

Page 5

REMARKS**Summary of the Office Action**

In the Office Action, claims 1-8 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,973,817 to *Robinson et al.* ("*Robinson*") in view of U.S. Patent No. 6,353,690 to *Kulishov*.

Summary of the Response to the Office Action

Applicants amend claims 1 and 5. Accordingly, claims 1-8 are pending for further consideration.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Claim 1-8 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Robinson* in view of *Kulishov*. This rejection is respectfully traversed in view of the above amendments to claims 1 and 5 and the following comments.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as obvious over *Robinson* in view of *Kulishov*. The Office Action states that "it would have been obvious to one of ordinary skill in the art to have used an interdigitated comb like structure in the system of *Robinson* as taught by *Kulishov*." Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third,

ATTORNEY DOCKET NO.: 053933-5008

Application No.: 09/821,738

Page 6

the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

The Office Action has not established a *prima facie* case of obviousness at least because neither *Robinson* nor *Kulishov*, whether alone or in combination, teach or suggest all the recited features of newly amended independent claims 1 and 5. Namely, neither *Robinson* nor *Kulishov* teach or suggest at least the features "wherein said voltages levels are such that a light amount ratio of a zero-order diffracted beam to a high-order diffracted beam of light is higher in a write mode than in a read mode," as recited in claim 1 and similarly in claim 5.

Applicants respectfully submit that neither *Robinson* nor *Kulishov* show or discuss a "light amount ratio" feature as recited in newly amended claims 1 and 5. Thus, Applicants respectfully submit that the applied references cannot make obvious the present invention. As such, the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully assert that independent claims 1 and 5 are distinguishable over the applied art and that the rejections under 35 U.S.C. § 103(a) should be withdrawn.

Additionally, Applicants respectfully submit that dependent claims 2-4 and 6-8 are also allowable insofar as they recite the patentable combinations of features recited in claims 1 and 5, as well as reciting additional features that further distinguish over the applied prior art.

ATTORNEY DOCKET NO.: 053933-5008

Application No.: 09/821,738

Page 7

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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